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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,416	11/15/2001	Steven A. Morse	80121-06507	3087

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,416

Applicant(s)

MORSE ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The disclosure is objected to because of the following informalities: Claim 9 is grammatically incorrect in that "rotatable" should be "rotatably" in lines 3-4. Appropriate correction is required.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The reissue oath/declaration must be signed by the inventors since applicant seeks to enlarge the scope of the claims (37 C.F.R. 1.172).

Claims 1-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 11, 14, 19 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 is confusing and inaccurate since it is inconsistent with the specification and drawings. Claim 10 is limited to the embodiment having first and second

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lumens. However, according to the specification and drawings, the embodiment having first and second lumens does not have a fluid seal in the second lumen near the distal end of the cannula as claimed. Although a seal 31 near the distal end of the cannula is disclosed (col. 3, lines 14-22), this seal is in an embodiment with only one lumen ("the inner lumen" referred to in col. 3, lines 17 and 20). Claim 28 is confusing and inaccurate for the same reason. As to claim 11, claim 9 (from which claim 11 depends) indicates that the instrument which is capable of being supported within the second lumen is not part of the claimed combination ("for supporting an instrument therein" in claim 9, line 6-7). However, claim 11 incorrectly implies that the instrument is part of the claimed combination since it includes the language "the instrument within the second lumen". Claim 14 has a similar problem. In claim 19, line 2, it is unclear if "abut" is meant to be "about".

Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bonutti (5,331,975). Bonutti, in figure 3 for example, discloses cannula 38 including a lumen for receiving an endoscope 40 therein, control rod 44 (Member 44 is a "control rod" since it can be rigid and since it moves member 46 as indicated in col. 7, lines 29-38.) which is eccentric of the lumen and

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dissection probe 46 (Member 46 is a dissection probe since it dissects tissue as indicated in col. 3, lines 21-30 and col. 7, lines 8-21 and 38-41.). Cannula 38 is inherently capable of being rotated about endoscope 40 since it is not fixed thereto. Alternatively, it would have been obvious that cannula 38 is capable of being rotated about endoscope 40 since it is not fixed thereto. As to claim 2, the distal portion of the lumen is considered to be the claimed recess. As to claim 7, the Bonutti specification fails to specifically indicate that the distal edges of the cannula 38 are excluded from the viewing field when the endoscope 40 is slightly recessed within the cannula 38. However, the viewing field of an endoscope is inherently limited, i.e. it extends from the endoscope distally in a cone but does not extend laterally at right angles to the endoscope. Therefore when the distal end of endoscope 40 is positioned just inside of cannula 38 at its distal edges, the distal edges of the cannula 38 would inherently be excluded from the viewing field. Alternatively, it would have been obvious that the distal edges of the cannula 38 would be excluded from the viewing field for this reason.

Claims 3, 4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,331,975). As to claims 3 and 4, Bonutti fails to disclose a fluid seal. However, it is old and

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well known in this art to provide fluid seals between the inner surface of a cannula and instruments or scopes inserted therein in order to prevent blood and gasses from escaping the patient. It would have been obvious to provide such a seal in the Bonutti cannula so that it too would have this advantage. As to claim 8, Bonutti, in the embodiment of figure 3, fails to disclose the dissection probe 46 being in the shape of a substantial loop. However, Bonutti, in the embodiment of figure 6 for example, teaches that the dissection probe 64 may have a toroidal (or loop) shape so that the scope may pass therethrough (col. 8, lines 13-25) and into the working space, apparently in order to view the area better. It would have been obvious to make the figure 3 dissection probe 46 so shaped so that it too would have this advantage.

Claims 9, 11, 14, 17, 18, 22-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bonutti (5,197,971). Bonutti, in figures 7-8 for example, discloses cannula 110 (Member 110 is a "cannula" noting col. 7, lines 11-14.) including first lumen 118 for receiving an endoscope and second lumen 116 eccentric of the first lumen 118 for supporting an instrument therein (col. 7, lines 41-43). The first lumen 118 is inherently capable of rotatably receiving an endoscope since the endoscope is slidable

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longitudinally within the lumen. Alternatively, it would have been obvious that first lumen 118 is capable of rotatably receiving an endoscope for this reason. As to claims 11 and 14, as best understood, the instrument within the second lumen is not part of the claimed combination.

Claims 10, 19-21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,197,971). Bonutti fails to disclose a fluid seal. However, it is old and well known in this art to provide fluid seals between the inner surface of a cannula and instruments or scopes inserted therein in order to prevent blood and gasses from escaping the patient. It would have been obvious to provide such a seal in the Bonutti cannula so that it too would have this advantage.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,331,975) in view of Okutsu (4,819,620). Bonutti, in the figure 3 embodiment, fails to disclose the step of selectively rotating endoscope 40 relative to cannula 38. However endoscope 40 has a slanted distal end as seen in figure 3. Further, Okutsu teaches that an endoscope 1 with a slanted distal end should be rotated within its outer tube in order to observe the areas around the endoscope (col. 3, lines 43-56). It would have been obvious to rotate endoscope 40 of Bonutti

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relative to cannula 38 so that the areas around the endoscope 40 would also be observed.

Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Green (5,928,137). Green, in the figures 31-33 embodiment, discloses the steps of assembling endoscope 905 within the lumen of a cannula 190 for rotation of the endoscope relative to the cannula (col. 15, lines 62-64), supporting an endoscopic instrument (the instrument having tip 380) for movement relative thereto (the rotational movement described in col. 11, lines 22-24), inserting the distal end of the cannula within a surgical site (col. 16, lines 1-3), rotating the endoscope relative to the cannula (col. 16, lines 3-5) and selectively positioning the endoscopic instrument relative to the cannula (by the rotation of the endoscopic instrument relative to the cannula described in col. 11, lines 22-24) for manipulating the operative tip of the endoscopic instrument.

Claims 12, 13 and 15 are free of any rejection based upon the prior art of record.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael



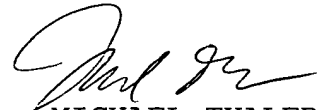
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Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and (703)872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
November 24, 2003



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731